

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-18, 20, and 21 are presently active. Claim 19 has been cancelled without prejudice; and Claims 1-18, 20, and 21 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, the Title was objected to as not being descriptive of the claimed invention; Claims 2-7, 9-11, 13, 14, 16, 18, and 19 were rejected under 35 U.S.C. § 112, second paragraph regarding the term “and/or” and questions of antecedent basis; Claims 15 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,880,731 to Liles et al. (hereinafter “the ‘731 patent”); Claims 1-4 and 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,219,045 B1 to Leahy et al. (hereinafter “the ‘045 patent”) in view of U.S. Patent No. 5,682,469 to Linnett et al. (hereinafter “the ‘469 patent”); Claims 5-7, 12-14, 18, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘045 and ‘469 patents, further in view of Smith (“Adding 3D visualization capabilities to GIS”) (hereinafter “the Smith reference”); and Claims 16, 17, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘731 patent.

In response to the objection to the Title, the Title has been amended to more clearly reflect the claimed invention. Accordingly, the objection to the Title is believed to have been overcome.

Regarding the rejections of Claims 2-7, 9-11, 13, 14, 16, 18 and 19 under 35 U.S.C. § 112, second paragraph, Claims 2-4, 6, 7, 9-11, 13, 14, and 16 have been amended to delete

the term “and/or.” Moreover, Claim 16 has been amended to address questions of antecedent basis, and Claim 19, which is a duplicate of Claim 18, has been cancelled without prejudice. Accordingly, Applicants respectfully submit that the rejection of the claims under 35 U.S.C. § 112 is rendered moot by the present amendment.

Amended Claim 1 is directed to a conversation support system for supporting a plurality of users in having a virtual conversation in a shared virtual space built and provided on a computer network, comprising: (1) enrolling means for enrolling an avatar of a logged-in user into the shared virtual space; (2) imparting means for imparting a virtual mobile telephone to each avatar in the shared virtual space, the shared virtual mobile telephone being usable within the shared virtual space; (3) determination means for determining, *in response to a call to a virtual mobile telephone, whether a calling party who originated the call exists in the shared virtual space*; and (4) connecting means for executing connection processing in accordance with the determination made by the determination means. Claim 1 has been amended for the purposes of clarification only, and no new matter has been added.

Regarding the rejection of Claim 1, the Office Action asserts that the ‘045 patent discloses everything in Claim 1 with the exception of the determination means and the connecting means, and relies on the ‘469 patent to remedy those deficiencies.

The ‘045 patent is directed to a three-dimensional graphical, multi-user, interactive virtual world system in which a plurality of users can interact with each other through avatars that represent each of the users in the virtual space. However, as noted in the Office Action, the ‘045 patent fails to disclose imparting means for imparting a virtual mobile telephone to each avatar in the shared virtual space, as recited in amended Claim 1. Moreover, the ‘045 patent fails to disclose determination means for determining, *in response to a call to a virtual mobile telephone, whether the calling party who originated the call exists in the virtual*

*reality space; and connecting means for executing connection processing in accordance with the determination made by the determination means.*

Turning now to the secondary reference, the '469 patent is directed to a software development platform having a user interface that serves as a vehicle for the user to invoke applications and perform tasks. The user interface provides a personal character that serves as an animated guide to assist the user in using the computer. In addition, the '469 patent discloses that specialized objects or characters may be provided to perform specialized tasks. For example, the '469 patent discloses that

a cellular phone object might be provided that follows a user from room to room. The cellular phone object flashes a light when the user has received voicemail and presents a custom balloon that lets you listen to messages or speed dial numbers when the object is clicked upon.<sup>2</sup>

However, Applicants respectfully submit that the '469 patent fails to disclose determination means for determining, *in response to a call to a virtual mobile telephone, whether a calling party who originated the call exists in the shared virtual space*, as recited in amended Claim 1. Rather, the '469 patent merely discloses a graphical user interface for operating a telephone, and does not contemplate determining whether a calling party who originated a call to a virtual mobile telephone exists in a shared virtual reality space. As a result, the '469 patent also fails to disclose connecting means for executing connection processing in accordance with the determination made by the determination means.

Thus, no matter how the teachings of the '045 and '469 patents are combined, the combination does not teach or suggest (1) determination means for determining, in response to a call to a virtual mobile telephone, whether a calling party who originated the call exists in the shared virtual reality space; and (2) connecting means for executing connection processing in accordance with a determination made by the determination means, as recited

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<sup>2</sup> '469 patent, col. 13, lines 12-17.

in Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 2-4) should be withdrawn.

Furthermore, Applicants note that the stated motivation for combining the teachings of the '045 and '469 patents is "in order to provide the user a convenient metaphor for the user to contact other users."<sup>3</sup> However, Applicants submit that the Office Action is simply stating perceived advantages of Applicants' invention as motivation to combine the '045 and '469 patents without identifying that, absent Applicants' specification, one of ordinary skill in the art would have even thought to address the problem. Such hindsight reconstruction of Applicants' invention cannot be used to establish a *prima facie* case of obviousness.

Amended Claim 8 recites limitations analogous to the limitations recited in amended Claim 1. Moreover, Claim 8 has been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 8 (and dependent Claims 9-11) should be withdrawn.

Regarding the rejection of independent Claim 5, the Office Action asserts that the '045 and '469 patents disclose everything in Claim 5 with the exception of a virtual *public* telephone, and relies on the Smith reference to remedy that deficiency.

The Smith reference is directed to a system for creating three-dimensional models of urban areas or other geographical features using VRML. In particular, the Smith reference discloses that trees are shown as green stars and "phone boxes" are shown as red squares. However, Applicants respectfully submit that the Smith reference fails to remedy the deficiencies of the '045 and '469 patents, as discussed above. In particular, even though the

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<sup>3</sup> Page 4 of the May 7, 2003, Office Action.

Smith reference discloses a “phone box,” the reference fails to disclose determination means for determining, in response to a call to a virtual public telephone, whether a calling party who originated the call exists in a shared virtual space, as recited in Claim 5.

Thus, no matter how the teachings of the ‘045 patent, ‘469 patent, and Smith reference are combined, the combination does not teach or suggest (1) determination means for determining, in response to a call to the virtual public telephone, whether a calling party who originated the call exists in the shared virtual reality space; and (2) connecting means for executing connection processing in accordance with the determination made by the determination means. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 5 (and dependent Claims 6 and 7) should be withdrawn.

Independent Claim 12 recites limitations analogous to the limitations recited in Claim 5. Accordingly, for the reasons stated above for the patentability of Claim 5, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 12 (and dependent Claim 13) should be withdrawn.

Regarding the rejection of dependent Claim 14, Applicants respectfully submit that the Smith reference fails to remedy the deficiencies of the ‘045 and ‘469 patents, as discussed above. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of dependent Claim 14 should be withdrawn.

Claim 18 recites limitations analogous to the limitations recited in independent Claim 5. Accordingly, for the reasons stated above for the patentability of Claim 5, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 18 should be withdrawn.

Applicants respectfully submit that the rejection of Claim 19 is rendered moot by the present cancellation of that claim.

Amended Claim 15 is directed to a conversation support method for supporting an activity of an avatar in a shared virtual space built and provided on a computer network, comprising: (1) receiving a request for sending a message from the avatar; (2) determining whether a destination of the message exists *in the real world*; and (3) executing connection processing in accordance with the determination made by the determining step. Claim 15 has been amended to clarify the step of determining whether a destination of the message exists *in the real world*. The amendment to Claim 15 is supported by the originally filed specification and does not add new matter.

Applicants respectfully submit that the rejection of Claim 15 as anticipated by the ‘731 patent is rendered moot by the present amendment to Claim 15.

The ‘731 patent is directed to a system in which avatars representing users in a graphical chat session are periodically animated to produce gestures that convey emotions, actions, or personality traits. As shown in Figure 12, the ‘731 patent discloses that a user may filter out and block messages received from other avatars outside a predefined “proximity radius”. However, Applicants respectfully submit that the ‘731 patent fails to disclose the step of determining whether a destination of a message exists *in the real world*, as recited in amended Claim 15. Rather, the ‘731 patent merely discloses filtering out messages received from other avatars existing in the virtual reality space who are not on a predetermined list. Accordingly, Applicants respectfully submit that amended Claim 15 patentably defines over the ‘731 patent.

Amended Claim 20 recites limitations analogous to the limitations recited in amended Claim 15. Moreover, Claim 20 has been amended in a manner analogous to the amendment to Claim 15. Accordingly, for the reasons stated above for the patentability of Claim 15, Applicants respectfully submit that the rejection of Claim 20 as anticipated by the ‘731 patent is rendered moot by the present amendment to Claim 20.

Applicants respectfully submit that the rejection of Claim 16, which depends from Claim 15, is rendered moot by the present amendment to Claim 15.

Applicants respectfully submit that the rejections of Claims 17 and 21 as obvious over the '731 patent are rendered moot by the present amendment to Claims 17 and 21. Claims 17 and 21 have been amended to clarify the step of receiving a request for sending a message from a *telephone* in the real world through a public telephone network in the real world. However, Applicants respectfully submit that the '731 patent fails to disclose receiving a request for sending a message from a telephone in the real world, as recited in Claims 17 and 21. Accordingly, Applicants submit that amended Claims 17 and 21 patentably define over the '731 patent.

Thus, it is respectfully submitted that independent Claims 1, 5, 8, 12, 15, 17, 18, 20 and 21 (and all associated dependent claims) patentably define over the '045 patent, the '469 patent, the '731 patent, and the Smith reference, taken either singly or in proper combination.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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